

### **REMARKS**

Upon entry of this Response, claims 1-132 remain pending in the present application. Claims 1, 4, 6-7, 9, 11, 14, 18-19, 30-31, 37, 49-50, 56, 68, 71, 77, 89, 94, 96, 102, 114, 116, and 120 have been amended. In addition, Applicants have added claim 132. Applicants request reconsideration of the pending claims in view of the following remarks.

As an initial matter, claims 1, 4, 6, 9, 11, 14, 18-19, 31, 37, 50, 56, 71, 77, 94, 96, 102, 116, and 120 have been amended herein to correct for various grammatical errors, antecedent basis errors, and to correct for incorrect dependencies where noted.

In item 2 of the Office Action, Examiner requests Applicants to submit any relevant art that was submitted during the court proceedings of *Scheduling.com, Inc. v. Eclipsys Corp. et al.*, Civil Action No. Civ00-496-TUC-WDB, United States District Court of for the District of Arizona. Other than the art previously submitted in this case, Applicants are unaware of any additional art identified during the indicated court proceedings that should be submitted.

In item 3 of the Office Action, the reissue oath/declaration filed with the application is considered defective as it is alleged that it fails to identify at least one error which is relied upon to support the reissue application. In response, Applicants submit herewith a new Oath/Declaration with a revised Statement of Inoperativeness to address any alleged insufficiencies. Accordingly, Applicants request Examiner's objection to the Statement of Inoperativeness be withdrawn.

In item 4 of the Office Action, claims 1, 7, 30, 49, 68, 89, and 114 are rejected under 35 U.S.C. §251 as being broadened in the reissue application filed outside the two year statutory limit. Applicants note that claims 1, 7, 30, 49, 68, 89, and 114 have been amended to overcome this objection by including previously allowed claim language "each of" the objects. In addition, claims 1, 7, 30, 49, 68, 89, and 114 have been narrowed by including "at least one of" the tiles. Accordingly, Applicants request that the rejection of claims 1, 7, 30, 49, 68, 89, and 114 under 35 U.S.C. §251 be withdrawn.

In item 7 of the Office Action, independent claims 7, 30, and 49 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as to the invention. In particular, it is alleged that the phrase "such as" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Claims 7, 30, and 49 have

been amended herein to address the substance of this rejection. Accordingly, Applicants request that the rejection of claims 7, 30, and 49 under 35 U.S.C. §112 be withdrawn.

In item 9 of the Office Action, independent claims 1, 7, 30, 89, 114 and dependent claims 2-6, 8-12, 14-15, 18-26, 28-29, 31-32, 37-45, 47-48, 90-97, 101-110, 112-113, 115-117, 119-128, 130-131 stand rejected under 35 U.S.C. §103(a) as being unpatentable over “Using 1-2-3 Special Edition.” A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicants request that the rejection of these claims be withdrawn.

To begin, independent claim 1 has been amended as follows:

1. In a computer system having input means for entering a plurality of objects to form an object list, data, ~~data~~ and commands into said system by a system user, an operator display module for displaying information to said user, a memory for storing said data and commands, and processing means for performing processing operations in response to the entry of said data and said commands by said user, a method of generating a display on said operator display module comprising the steps in sequence of:

- (a) entering a command into said system by said user to display a form;
- (b) in response to said command, using said processing means to obtain said object list, corresponding to said form, from said memory;
- (c) using said processing means, assigning at least one of a plurality of tiles to each of said objects in said object list, in the following manner: at least one of said tiles being assigned to a group of said objects, and at least a second of said tiles being assigned to a single an individual one of said objects; and
- (d) using said processing means, displaying said tiles on said operator display module.

In regard to amended claim 1, the Office Action alleges that steps (a)-(d) are taught by “Using 1-2-3 Special Edition” (hereinafter referred to as “1-2-3”), except for “assigning a single tile to a group of objects and assigning a single tile to an individual object” which are alleged to be an obvious modification. Contrary to the Examiner’s rejection, steps (b)-(d) performed by the “processing means” recited in amended claim 1 are not taught or suggested by 1-2-3 because 1-2-3 cannot assign “tiles to each of said objects in said object list”. Every step recited in amended claim 1 is automatically executing according to a program running on the “computer system”

except for step (a). Step (a) requires a system user's input to display a form. After the system user enters the command, the computer system via the "processing means" generates the shape and size of the tiles and hence the form based on the object and data to be displayed by "assigning at least one of a plurality of tiles to each of said objects in said object list" as recited in step (c) of amended claim 1.

In contrast to the claimed invention, *I-2-3* is a static spreadsheet program. Significantly, an entry in one cell of the spreadsheet remains in that particular cell until a user changes it. Once the user inputs the information into a particular cell, *I-2-3* will store this information which can be retrieved later. The spreadsheet never changes – the information will appear according to how the user entered it. *I-2-3* does not assign "tiles to each of said objects" via the "processing means" as recited in amended claim 1 because the user must physically change how the information is displayed before the display itself changes. Thus, the information in *I-2-3* does not change based on "objects" in an "object list" as recited in amended claim 1. The *I-2-3* spreadsheet is static and changeable only by the user while the claimed method is dynamic and changeable by the computer based on objects and data to be viewed.

The "tiles" in the claimed invention vary in size and shape as discussed in the specification of the subject application. (See FIGS. 4, 5A-5C and related discussion at column 5, line 60 to column 6, line 22). However, there is no variance of the size and shape of the cells of the spreadsheet based on information entered by the user. The cells as well as the form on *I-2-3* is static. Moreover, the *I-2-3* spreadsheet is predetermined and stored somewhere in the system. *I-2-3* does not have the capability to modify the form dependent upon the user or information being displayed by "assigning at least one of a plurality of tiles to each of said objects in said object list" as recited in amended claim 1.

In addition, independent claims 7, 30, 89, and 114 have been rejected in item 9 of the Office Action under 35 U.S.C. §103(a) as being unpatentable over *I-2-3*. Applicants assert that amended claims 7, 30, 89, and 114 are in condition for allowance for the same reasons described above with respect to amended independent claim 1. Contrary to the Examiner's rejection, steps performed by the "processing means" and "processor designed to perform processing operations" recited in the amended claims are not taught or suggested by *I-2-3* because *I-2-3* cannot associate "tiles with each of said objects" in said object list. *I-2-3* does not have the capability to modify the form dependent upon the user or information being displayed by

“associating at least one of a plurality of tiles with each of said objects” in said object list as recited in the amended claims.

It should be noted that Applicants have amended independent claims 1, 7, 30, 89, and 114 to include claim language that previously put claims 1 and 7 in condition for allowance over the cited reference. In this respect, Applicants refer the Examiner to the Amendment Under 37 C.F.R. §1.116 filed in the original application on October 19, 1992 and the subsequent Notice of Allowance mailed on November 13, 1992. Accordingly, Applicants request that the rejection of independent claims 1, 7, 30, 89, and 114 be withdrawn. In addition, Applicants request that the rejection of claims 2-6, 8-12, 14-15, 18-26, 28-29, 31-32, 37-45, 47-48, 90-97, 101-110, 112-113, 115-117, 119-128, 130-131 be withdrawn as depending from independent claims 1, 7, 30, 89, or 114.

In item 10 of the Office Action, independent claims 49, 68 and dependent claims 13, 17, 27, 36, 46, 50-51, 55-67, 69-72, 76-88, 101, 111, 119, 129 stand rejected under 35 U.S.C. §103(a) as being unpatentable over “Using 1-2-3 Special Edition” in view of Cobb et al., “Excel In Business.” A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicants request that the rejection of independent claims 49, 68 and dependent claims 13, 17, 27, 36, 46, 50-51, 55-67, 69-72, 76-88, 101, 111, 119, 129 be withdrawn.

Applicants assert that amended claims 49 and 68 are in condition for allowance for the same reasons described above with respect to amended independent claim 1. Accordingly, Applicants request that the rejection of independent claims 49 and 68 be withdrawn.

In addition, Applicants request that the rejection of claims 13, 17, 27, 36, 46, 50-51, 55-67, 69-72, 76-88, 101, 111, 119, 129 be withdrawn as depending from independent claims 1, 30, 49, 68, 89, or 114.

In item 11 of the Office Action, claims 16, 33-35, 98-100, and 118 stand rejected under 35 U.S.C. §103(a) as being unpatentable over “Using 1-2-3 Special Edition” in view of McDonald et al., “The Benefits of Automated Medical Record Systems For Ambulatory Care.” A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Claims 16, 33-35, 98-100, and 118 depend from independent claims 1,

30, 89, and 114, respectively. Accordingly, Applicant requests that the rejection of claims 16, 33-35, 98-100, and 118 be withdrawn as depending from claims 1, 30, 89, and 114 for the same reasons described above with respect to claims 1, 30, 89, and 114.

In item 12 of the Office Action, dependent claims 52-54 and 73-75 are rejected under 35 U.S.C. §103(a) as being unpatentable over “Using 1-2-3 Special Edition” in view of Cobb et al., “Excel In Business,” and further in view of McDonald et al., “The Benefits of Automated Medical Record Systems For Ambulatory Care.” A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Claims 52-54 and 73-75 depend from independent claims 49 and 68. Applicants request that the rejection of claims 52-54 and 73-75 be withdrawn as depending from claims 49 and 68 for the reasons described above with respect to claims 49 and 69.

**CONCLUSION**

It is requested that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this Response, the Examiner is encouraged to telephone the undersigned counsel of Applicants.

Respectfully submitted,

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